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**FEB 16 2006**

**OFFICE OF PETITIONS**

In re Application of  
Botstein et al.  
Application No. 09/944,944  
Filed: August 31, 2001  
Attorney Docket No. 10466/137

: DECISION DISMISSING PETITION

This is a decision on the “RESUBMISSION OF APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)” timely filed October 18, 2005. Applicants request that the patent issuing from the above-identified patent application be afforded a patent term adjustment of six hundred and eighty-nine (689) days rather than the Office determination of 444 days. The earlier request for reconsideration was held in abeyance until the patent issue date.

The applicants’ request for additional PTA is dismissed.

Applicants request an additional two hundred and forty-five days (245) of PTA based upon the application failing to issue within three years of the filing date. See 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b).

Applicants arguments are not persuasive. The Office notes that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

In the present application, applicant received four hundred and fifty days for the Office failure to comply with 35 U.S.C. 154(b)(1)(A)(i),(ii), and (iv) and 37 CFR 1.702(a)(1), (2), and (4). Accordingly, because such periods overlap within the meaning of 37 CFR 1.703(f) , applicants are not granted any additional PTA beyond what already has been awarded.

The re-submission does not require a fee since the sole reason for re-submission relates the determination that the application does not receive any additional time under 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) and that applicant paid the fee with the earlier request that was held in abeyance.

The application file is being forwarded to the file repository for storage of the patented filed.

Telephone inquiries specific to this matter should be directed to Alesia Brown, Petitions Attorney, Office of Petitions, at (571) 272-3205.

*Kery Fries*

Kery Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

cc: Pair calculation

Day : Wednesday

Date: 2/15/2006  
Time: 14:00:36**PALM INTRANET****PTA Calculations for Application: 09/944944**

Application Filing Date:	08/31/2001	PTO Delay (PTO):	450
Issue Date of Patent:	08/16/2005	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	6
Post-Issue Petitions:	0	Total PTA (days):	444
PTO Delay Adjustment:	0		

**File Contents History**

Number	Date	Contents Description	PTO	APPL	START
48.5	07/27/2005	PTA 36 MONTHS			
48	08/16/2005	PATENT ISSUE DATE USED IN PTA CALCULATION	60		44
47	07/14/2005	RECEIPT INTO PUBS			
46	07/14/2005	DISPATCH TO FDC			
45	07/14/2005	APPLICATION IS CONSIDERED READY FOR ISSUE			
44	02/17/2005	ISSUE FEE PAYMENT VERIFIED			
43	07/05/2005	RECEIPT INTO PUBS			
42	06/06/2005	PETITION DECISION - DISMISSED			
41	02/16/2005	PETITION ENTERED			
40	02/16/2005	WORKFLOW INCOMING PETITION IFW			
39	02/17/2005	ISSUE FEE PAYMENT RECEIVED			
38	02/16/2005	SEQUENCE FORWARDED TO PUBS ON TAPE			
37	01/19/2005	EXPORT TO INITIAL DATA CAPTURE			
36	01/25/2005	WORKFLOW - FILE SENT TO CONTRACTOR			
35	01/06/2005	MAIL NOTICE OF ALLOWANCE	45		28
34	01/05/2005	ISSUE REVISION COMPLETED			
33	01/04/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
32	01/04/2005	NOTICE OF ALLOWABILITY			
31	10/16/2004	CORRESPONDENCE ADDRESS CHANGE			
30	10/18/2004	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
29	07/29/2004	DATE FORWARDED TO EXAMINER			
28	07/22/2004	AMENDMENT AFTER FINAL REJECTION			
27	07/22/2004	WORKFLOW INCOMING AMENDMENT IFW			

26	05/17/2004	MAIL FINAL REJECTION (PTOL - 326)	32		22
25	05/14/2004	FINAL REJECTION			
24	04/22/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
23	04/22/2004	DATE FORWARDED TO EXAMINER			
22	12/15/2003	RESPONSE AFTER NON-FINAL ACTION	6	19	
19	09/09/2003	MAIL NON-FINAL REJECTION	313		-1
18	09/08/2003	NON-FINAL REJECTION			
17	04/22/2003	CASE DOCKETED TO EXAMINER IN GAU			
16	12/20/2002	CASE DOCKETED TO EXAMINER IN GAU			
15	09/03/2002	PRELIMINARY AMENDMENT			
14	09/03/2002	PRELIMINARY AMENDMENT			
13	05/01/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	02/11/2002	CASE DOCKETED TO EXAMINER IN GAU			
11	02/06/2002	CASE DOCKETED TO EXAMINER IN GAU			
10	02/06/2002	CASE DOCKETED TO EXAMINER IN GAU			
9	12/20/2001	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
8	08/31/2001	PRELIMINARY AMENDMENT			
7	11/28/2001	CASE DOCKETED TO EXAMINER IN GAU			
6	11/09/2001	APPLICATION DISPATCHED FROM OIPE			
5	11/07/2001	CORRESPONDENCE ADDRESS CHANGE			
4	10/26/2001	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
3	09/14/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	08/31/2001	CRF DISK HAS BEEN RECEIVED BY PREEEXAM / GROUP / PCT			
1	08/31/2001	INITIAL EXAM TEAM NN			

Search Another: Application#

#### EXPLANATION OF PTA CALCULATION

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